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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055679
Party	Defendant Malovani Design Corp. DBA Your Photo On Canvas
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Attachments	Reply re TTAB Motion [Final].pdf ( 6 pages )(158594 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Related Matters of:**

**Matter 1:** Trademark Application Serial No. 85/252823  
**Mark:** Your Photo On Canvas  
**Date Filed:** February 27, 2011  
**Date Published:** May 15, 2012

**Matter 2:** Trademark Application Serial No. 85/249731  
**Mark:** Your Photo On Canvas  
**Date Filed:** February 23, 2011  
**Date Registered:** May 29, 2012

YOUR PHOTO ON CANVAS, LLC,  Opposer/Petitioner,  vs.  MALOVANI DESIGN CORP.,  Applicant/Registrant.	Opposition No. 91205200  Serial No. 85/252823 <hr/> Cancellation No. 92055679  Registration No. 4151869  Serial No. 85/249731
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**APPLICANT AND REGISTRANT’S BRIEF REPLY RE MOTION TO SUSPEND  
PROCEEDINGS, TO CONSOLIDATE CASES, OR, IN THE ALTERNATIVE, TO  
EXTEND TIME TO RESPOND TO OPPOSER AND PETITIONER’S MOTIONS FOR  
SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND AUTHORITIES**

Applicant and Registrant MALOVANI DESIGN CORPORATION (“Applicant,” “Registrant” or “Malovani Design”) hereby submits this brief reply regarding its motion for: (1) a suspension of the proceedings before the Board in both of the instant proceedings, Opposition No. 91205200 (the “Opposition Proceeding”) and Cancellation No. 92055679 (the “Cancellation Proceeding”), pending final resolution of the related and previously filed United States District Court case of Malovani v. Doe, Case No. 8:11-cv-00787-AG-MLG; (2) to consolidate the related

Opposition and Cancellation Proceedings at issue here, which involve common questions of law and fact; or, in the alternative, (3) in the event that the Motion to Suspend Proceedings is denied, to extend the time in which Applicant and Registrant may respond to Opposer and Petitioner Your Photo on Canvas, LLC's ("Opposer," "Petitioner" or the "LLC") two Motions for Summary Judgment to thirty days from the date of denial.

This Reply is based on the attached Memorandum of Points and Authorities and the documents on file in this action.

Dated: March 8, 2013

Respectfully submitted,

SILVERMAN SHIN BYRNE & GILCHREST LLP

s/Robert M. Gilchrest/  
Robert M. Gilchrest  
Amy S. Russell  
Attorneys for Applicant and Registrant  
MALOVANI DESIGN CORPORATION

## **MEMORANDUM OF POINTS AND AUTHORITIES**

### **I. Brief Reply**

Applicant and Registrant MALOVANI DESIGN CORPORATION (“Applicant,” “Registrant” or “Malovani Design”) hereby submits this brief reply and asks the Trademark Trial and Appeal Board (the “Board” or “TTAB”) to grant its motion to (1) suspend the instant proceedings; (2) to consolidate Opposition No. 91205200 (the “Opposition Proceeding”) and Cancellation No. 92055679 (the “Cancellation Proceeding”); or, (3) in the alternative and in the event that the Motion to Suspend Proceedings is denied, to extend the time to respond to Opposer and Petitioner Your Photo on Canvas, LLC’s (“Opposer,” “Petitioner” or the “LLC”) two Motions for Summary Judgment.

Of primary relevance to this Reply is the fact that Opposer and Petitioner fails entirely, in its Opposition Papers, to address the core issues presented by Applicant and Registrant’s Motion. Opposer and Petitioner argues for the granting of its Motions for Summary Judgment, despite the fact that the substance of the summary judgment claims were not addressed in the Moving Papers relevant to this Motion, yet fails to address the fact that suspension of a Board proceeding is warranted where, as here, a pending civil action may have a preclusive effect on the proceedings before the Board. Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 510. Most critically, this rule applies because: “To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.” TBMP § 510.02(a). The United States District Court case *Malovani v. Doe*, Case No. 8:11-cv-00787-AG-MLG (the “Malovani matter”), is currently in trial before the Honorable Andrew J. Guilford, and the jury trial is expected to conclude on March 13, 2013.

The Opposition Papers also fail to address the fact that, in its Order Denying Motion for Partial Summary Judgment (the “District Court Order”) in the Malovani matter, the U.S. District Court issued a ruling that is entirely preclusive of the actions pending before the Board in these

proceedings. Regarding the relevance of the ownership of the “Your Photo on Canvas” trademark, specifically as between Adam Malovani and Malovani Design, which is controlled entirely by Adam Malovani, the Court held that the technical title-holder is irrelevant to the ability to enforce the trademark rights:

The Ninth Circuit authority controls for both jurisdictional and equitable reasons. Like in Jules, this is a case of an individual and his “one-man shop.” Obviously, there is no dispute between these two entities because the same individual controls both. Unlike Gaia, title could have been transferred easily from one to the other without any chain of title issues.

[Declaration of Robert M. Gilchrest, Ex. I at p.8.]

The District Court Order makes clear that, despite Opposer and Petitioner’s claim that the civil Malovani matter involves different issues than the matters pending before the Board, the issue of the ownership of the mark is relevant to both actions. As the Opposition Papers demonstrate, Opposer and Petitioner’s claims in opposition to the registration of the trademark at issue are based solely on the argument that Adam Malovani, and not Malovani Design, owned the trademark at the time of the filing of the applications. The District Court Order is therefore dispositive of Opposer and Petitioner’s claim that Applicant and Registrant was not the owner of the subject marks and for that reason should be refused registration of the mark “Your Photo on Canvas.”

Finally, Opposer and Petitioner cites to cases prohibiting mid-litigation assignments in an attempt to demonstrate that the issues presented to the Board are different from the issues previously decided by the U.S. District Court. In this instance, Opposer and Petitioner’s comparison is misplaced because the issues presented by the facts of this case simply are not present in the referenced cases. Particularly, Adam Malovani at all times was and currently is the sole owner and operator of Malovani Design, a one-man shop. This fact drives the policy considerations at play before both the Board and the U.S. District Court, and the cases cited by Opposer and Petitioner are not relevant because they do not consider the issue. See Gaia

Technologies, Inc. v. Reconversion Technologies, Inc., 93 F.3d 774 (Fed. Cir. 1996) (intellectual property was sold to a third party in the course of bankruptcy proceedings).

## **II. Conclusion**

For the foregoing reasons and for those presented in the Moving Papers, Applicant and Registrant respectfully requests that the Trademark Trial and Appeal Board (1) stay the instant Opposition and Cancellation Proceedings pending final resolution of the related U.S. District Court case of Malovani v. Doe, (2) consolidate the related Opposition and Cancellation Proceedings pending before the Board, or, in the alternative, (3) extend the time to respond to Opposer and Petitioner's two Motions for Summary Judgment, in the event that the Motion to Suspend Proceedings is denied, to thirty days from the date of denial.

Dated: March 8, 2013

Respectfully submitted,

SILVERMAN SHIN BYRNE & GILCHREST LLP

s/Robert M. Gilchrest/

Robert M. Gilchrest

Amy S. Russell

Attorneys for Applicant and Registrant

MALOVANI DESIGN CORPORATION

**CERTIFICATE OF SERVICE**

I hereby certify that on the 8th day of March, 2013, I caused a copy of APPLICANT AND REGISTRANT'S BRIEF REPLY RE MOTION TO SUSPEND PROCEEDINGS, TO CONSOLIDATE CASES, OR, IN THE ALTERNATIVE, TO EXTEND TIME TO RESPOND TO OPPOSER AND PETITIONER'S MOTIONS FOR SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND AUTHORITIES to be served upon the following counsel by depositing the same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

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Attorneys for Opposer and Petitioner  
YOUR PHOTO ON CANVAS, LLC

Dated: March 8, 2013

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s/Robert M. Gilchrest/  
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